

REMARKS

Claims 2-11 and 13-17 are present in the instant application. Claim 12 has been cancelled without disclaimer or prejudice to its subsequent reintroduction in this or a continuing application. In the most recent Office Action, Claims 2-7, 9-11 and 13 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Pat. No. 3,743,867 to Smith, Jr. (hereinafter, "Smith, Jr."). Claim 8 is rejected under 35 U.S.C. § 103(a) as allegedly obvious over Smith, Jr. Claim 12 is rejected under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Pat. No. 3,082,337 to Horsley (hereinafter, "Horsley") in view of Smith, Jr.

By the above amendment, new Claims 14-17 are presented. The features of these claims find support generally throughout the specification as originally filed, and specifically at, among other places, page 8, lines 8-29, and Figs 3, 5. No new matter has been added.

Applicants respectfully traverse all rejections, for at least the reasons set forth below. Independent claims 2, 10 and 13 each recite a rotating machine comprising, *inter alia*, at least two field windings comprising an outer jacket, and a plurality of conductive wires disposed within and enclosed by the outer jacket such that longitudinal passages are defined therebetween. Smith, Jr. discloses conductors (32) and interstitial spaces (31) between the conductors, and unfilled spaces (30) in various slots, but lacks any teaching of an outer jacket enclosing at least two of the field windings, a plurality of which are disposed in each field winding slot.

Moreover, Claim 10 recites a rotating machine comprising, *inter alia*, the conductive wires being wound within the outer jacket to form helical shaped longitudinal


passages. Having no teaching of an outer jacket, this feature is neither taught nor suggested by Smith, Jr., notwithstanding the disclosure at Col. 3, lines 27-30.

It has been held by the courts that "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir., 1984). Because Smith, Jr. fails to teach or suggest all the features of Claim 2, Applicant respectfully submits that the present invention is patentably distinguished over Smith, Jr. Claims 3-9 and 11 are each separately patentable, but are submitted as patentable for at least the same reasons as Claim 2, from which they directly or indirectly depend. Favorable reconsideration and withdrawal of the rejection of Claims 2-11 and 13 is kindly requested.

With respect to Claim 8, the averred motivation to modify Smith, Jr. does not ameliorate the noted deficiency with respect to underlying Claim 2. All claim elements must be taught or suggested in the prior art to establish prima facie obviousness. See, *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Therefore, Applicant submits that Claim 8 is likewise patentably distinguished over Smith, Jr. Favorable reconsideration and withdrawal of the rejection of Claim 8 is kindly requested.

In light of the foregoing, Applicants respectfully submit that all claims recite patentable subject matter, and kindly solicit an early indication of allowability. If the Examiner has any reservation in allowing the claims, and believes a telephone interview would advance prosecution, he is kindly requested to telephone the undersigned at his earliest convenience.

Respectfully Submitted,



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